

REMARKS

35 U.S.C. 103

Claims 1, 2, and 5-13 have been rejected under 35 U.S.C. 103(a) over Stewart et al. U. S. Patent No. 6,389,460, Sutcliffe et al. U. S. Patent 6,253,216, and Moseley, et al. "Mastering Microsoft Office 97".

Applicants traverse, and argue that the Examiner has not established a prima facie case of obviousness, which requires that the Examiner provides

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The fourth element of the prima facie case, the suggestion to combine, must come from the prior art. It is

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insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. [See *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997)]. That a claimed invention may employ known principles does not itself establish that the invention would have been obvious, particularly where those principles are employed to deal with different problems. [See *Lindermann, supra.*] The Examiner must consider the claim as a whole, and not piece together the claimed invention using the claims as a guide. The Federal Circuit has stated: "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. [See *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992)].

Applicants assert that this reconstruction, using applicants' own invention as a road map, is just what the Examiner has done.

"In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach

a conclusion of obviousness under § 103, the Examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). (Ex parte Rao S. Chintakrindi, Thomas E. Murphy, Paul F. Rieth and Jeffrey S. Stevens, Non-binding decision of the Board of Patent Appeals and Interferences, 9/30/2003 in Appeal No. 2001-2578, Application No. 08/977,547 filed 25 Nov 1997, END919970136US1.)

"A rejection under 35 U.S.C. § 103 must be based on whether there is a teaching, motivation, or suggestion to select and combine the references based on objective evidence of record. Therefore, the Examiner must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co.

v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996).” (Ex parte Rao S. Chintakrindi, Thomas E. Murphy, Paul F. Rieth and Jeffrey S. Stevens, Non-binding decision of the Board of Patent Appeals and Interferences, 9/30/2003 in Appeal No. 2001-2578, Application No. 08/977,547 filed 25 Nov 1997, END919970136US1.)

In the present case, the Examiner has assembled a hypothetical system “wherein a graphic request locator is hashed to search for an image within a cache. If the image is not found, the system generates a new image from the image parameters stored in a database.” [Office Action, pages 4-5] Further, “In the proposed combination of Stewart, Sutcliffe, and Moseley discussed above, images would be stored in a cache as taught by Stewart and in a database of parameters as taught by Sutcliffe. The invention would first search the cache for the desired image as taught by Stewart. Then, if the requested image were not found in the cache, it would be reconstructed from its associated parameters as taught by Sutcliffe.” [Office Action, page 6].

Sutcliffe does not related to generating images, but

rather relates to the generation of personal web pages.

[Col. 2, lines 21-53]. Applicants' invention relates to the generation of images, to the dynamic, on the fly generation of images based on a set of parameters. Web pages are not images. A .gif file is an example of an image.

Further, as applicants will explain hereafter, Stewart teaches away from the hypothetical combination suggested by the Examiner, and the combination of Stewart, Sutcliffe, and Moseley can only be deemed to teach applicants invention when assembled using applicants own claims as a road map, and by ignoring that Sutcliffe is generating personal web pages (not images) and that Stewart does not dynamically generate images.

Applicants' graphics server provides the ability to construct an image that is independent from the display medium of the browser. This image is constructed based on (1) the text string, which can be any text string; (2) the font selection; (3) the font color, size, effect (e.g., italics, etc.); (4) text effect to blur or shadow the text string; (5) the background color and/or image; and (6) image effect on the combination of text string and effect with the background image (e.g., button shading, rounding corners).

Each of these items can vary independently. Applicants' invention, as claimed, includes the following: receiving an insert graphics command from a user, responding with an insert graphics screen, the user selecting graphics effects parameters, storing the graphics and text as an image to cache and parameters to a database, responsive to a request from a browser user, a server displays the image from cache or, if not available from cache, dynamically generates the image anew from the parameters stored to the database.

Sutcliffe relates to a system and method where the user starts with a graphics template page for generating a personal web page, and selects from that template graphics attributes. Sutcliffe's template page dictates a specific form to the page indicating where a graphic item will appear, where a text string will appear, and so forth. In applicants' model, the user has a page body within which to freely add text and graphics, in any format and position desired, dynamically generated images (for those not found in cache).

Stewart relates to techniques for storing objects and retrieving objects from a storage device used as a cache device. There is no teaching in Stewart of selectively

displaying images secured from cache or dynamically generating from a set of parameters in a database.

Mosely describes the Microsoft Office 97 user interface, which provides for an insertion point (cursor) and a font dialog box containing character formatting options. Mosely provides no teaching with respect to storing the graphics and text as an image to cache and parameters to a database, and responsive to a request from a browser user, selectively displaying the image from cache or, if not available from cache, dynamically generating the image anew from the parameters stored to the database

Further, applicants' claims are directed to a method and system for a graphics server that generates an image that does not exist anywhere when not found in cache. The Examiner states:

"...neither Sutcliffe nor Moseley disclose a cache for storing the graphics and text as an image. Stewart, however, discloses in column 3, lines 61-67 and column 4, lines 1-20 an invention for storing and retrieving objects in a rapid and efficient manner... In Figure 2, Stewart illustrates a proxy cache [208] for storing

images. Stewart further discloses in column 16, lines 49-67 and column 17, lines 1-20 a hashing system for establishing a directory structure of cached images. Columns 18-20 detail the process of receiving a graphic request locator, hashing the request to form a string, locating the cached image, and serving the image to a browser. Because the size of the cache is limited, however, it can only provide temporary storage. Accordingly, Stewart discloses in column 19, lines 62-67 and column 20, lines 1-11, logic for handling a request for an image not located in cache. Stewart explains that when the image is not found, the system attempts to retrieve the image from an alternate location. In column 2, lines 39-45, Stewart provides motivation for adding a caching mechanism to the hypothetical invention of Sutcliffe and Moseley. Stewart explains in this section that organizations can more efficiently share the bandwidth of an Internet connection by storing frequently accessed Internet material. Accordingly it would have been obvious... to further improve the hypothetical invention of Sutcliffe and Moseley by utilizing a cache as taught by Stewart. In the combined invention, images would be stored in a cache and in a database of parameters. The invention

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would first search the cache for the desired image as taught by Stewart. Then, if the requested image is not found in the cache, it could be reconstructed from its associated parameters as taught by Sutcliffe. This combination would be superior to the hypothetical invention of Sutcliffe and Moseley because of the increased efficiency." [Office Action, pages 3-4. Emphasis added.]

The relevant teaching of Stewart is as follows:

"The proxy cache 208 operates as a cache storage area in which responses to earlier requests from the Internet 106 made by the browsers 104 can be temporarily saved and satisfied thereafter from the proxy cache 208 if any of the browsers 104 make the same request for data while the data remains stored in the proxy cache 208." [Stewart, Col. 8, lines 52-57.]

"Further, when the decision 716 determines that the file does not exist or when the file wait processing 724 has determined that it does not wish to wait any longer for the state of the requested file to obtain the "DONE"state, a decision block 725 determines

whether another image type is available from the proxy system (e.g., a less accelerated version or the original image). If there is another image type available, then the image retrieval processing 700 returns to repeat the decision block 718 and subsequent blocks. On the other hand, when the decision block 725 determines that there are no other image types available from the proxy system, then the image retrieval processing 700 operates to request 726 the image from the remote content server. Thereafter, once the requested image has been received, it is able to be forwarded to the requester in block 722...." [Stewart, Col. 19, line 62 to col. 20, line 8. Emphasis added.]

Stewart teaches that, in effect, if a desired image is not found in cache, it must be retrieved from some alternate location, such as proxy system or a remote content server. This teaching leads away from applicants' invention which, if the image is not found in cache, is dynamically regenerated as set forth in applicants' claims and describe in their specification:

"In step 371, with the cursor positioned at the point 364 in edit screen 361 where the graphic is to be

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inserted, the user selects insert graphic text button 367. In step 373, insert graphics screen 362 is presented to the user which includes a text area 261, and buttons and drop down menus for selecting various parameters, including effect, animation, color, size, and so forth. In step 374, when the user selects done 365, edit screen 361 is presented with the image appearing at the selected point 364." [Specification, page 66, lines 1-10].

"Referring to Figure 25 and Figure 26, graphics server 350 functions as follows. In step 380, the server receives the URL of a graphic request, such as from step 375 (Figure 24). In step 381, the URL string is hashed to obtain a hash number that, in step 382, is used to look for an image in cache with a matching hash number. If, in step 383, that matching image is found, in step 384 the image is served in response to the request. However, if that matching image is not found, the image must be regenerated. In step 385, the URL from the request is parsed to obtain the graphic parameters which, in step 386, are used to construct the graphic server objects, using default parameters for any necessary parameters missing from the URL."

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[Specification, starting at about page 64, line 9.

Emphasis added.]

In conclusion, as the Examiner states, neither Sutcliffe nor Moseley teach applicants system and method for storing the graphics and text as an image in a cache. Stewart describes storing images in a cache but, unlike applicants' claimed invention, when a desired image is not found in cache it must access some alternative location to retrieve it. Applicants, on the other hand, generate the image anew. Sutcliffe teaches generating personal web pages, and these are not images.

Stewart's teachings, therefore, when considered in combination with Sutcliffe and Moseley, teach away from a graphics server which first accesses cache for the image, and not finding the image in cache, rather than searching for the image in an alternate location, generates it anew.

The Examiner states:

"Applicant asserts that Stewart teaches retrieving an image from an alternate location when it is not found in the cache and thus teaches away from the claimed

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invention. The examiner submits that the test for obviousness is not whether all of the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Even though Stewart teaches looking elsewhere for an image when it is not found in the cache, this teaching does not affect the proposed combination. The reason said teaching was mentioned in the first place was to show that Stewart discloses "either or" logic similar to that claimed by Applicant (i.e. if the image is found in the cache, one step is performed; if the image is not found in the cache, a different step is performed). In the proposed combination of Stewart, Sutcliffe, and Moseley discussed above, images would be stored in a cache as taught by Stewart and in a database of parameters as taught by Sutcliffe. The invention would first search the cache for the desired image as taught by Stewart. Then, if the requested image were not found in the cache, it would be

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reconstructed from its associated parameters as taught by Sutcliffe." [Office Action, page 6].

In reply, applicants argue that Sutcliffe does not teach the generation of images, but rather web pages. Moseley, Sutcliffe and Steward do not teach applicants dynamic, on the fly generation of images from parameters stored in a database when a requested image is not found in cache.

Applicants have amended the independent claims to focus attention on the generation and display of images.

SUMMARY AND CONCLUSION

Applicants urge that the amendment be entered and the case be passed to issue with claims 1-2 and 5-13.

The Application is believed to be in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one or more of the remaining claims in condition for allowance, the

Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Sincerely,

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By


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